

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Sweeney, Patrick J.  
Title: METHOD AND DEVICE FOR DELIVERING MEDICINE TO BONE  
Appl. No.: 10/682,307  
Filing Date: 10/9/2003  
Patent No.: 7,608,062  
Grant Date: 10/27/2009  
Examiner: Bouchelle, Laura A.  
Art Unit: 3763  
Conf. No.: 7309

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**  
**UNDER 37 C.F.R. §1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on October 27, 2009, as U.S. Patent No. 7,608,062.

The Patent Office determined that the patent was entitled to 576 days of PTA. Applicant believes that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA

statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of “overlap” are limited to “periods of time . . . [that] occur on the same day.” *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays “occur on the same day.” *Id.*

Applicant has recalculated PTA for the captioned patent under the court’s interpretation of the PTA statute, and has determined that the patent is entitled to 951 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

|                                                                   |           |
|-------------------------------------------------------------------|-----------|
| (a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): | 1068 days |
| (b) Total Applicant delay:                                        | 117 days  |
| Final PTA Determination:                                          | 951 days  |

Applicant therefore respectfully requests that the patent be accorded 951 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicant requests further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date December 23, 2009

By /James D. Borchardt/

FOLEY & LARDNER LLP

Customer Number: 26371

Telephone: (414) 319-7077

Facsimile: (414) 297-4900

James D. Borchardt

Attorney for Applicant

Registration No. 62,025

CLOSE WINDOW

ALL CASES

SELECT CASE

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 029815-0104

Application Number: 10/682307

Patent Number: N/A

|             | Event Description                                                   | Event Date | Days from Filing | PTO Days   | Applicant Days |
|-------------|---------------------------------------------------------------------|------------|------------------|------------|----------------|
| Edit Delete | Application Filing Date                                             | 10/09/2003 | 0                |            |                |
| Edit Delete | Preliminary Amendment NOT falling under 1.704(c)(6) Received at PTO | 11/03/2003 | 25               |            |                |
| Edit Delete | Notice to File Missing Parts                                        | 01/09/2004 | 92               |            |                |
| Edit Delete | Response to Notice to File Missing Parts                            | 03/08/2004 | 151              |            |                |
|             | 14 month From Application date                                      | 12/09/2004 | 427              |            |                |
| Edit Delete | IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO         | 12/30/2004 | 448              |            |                |
| Edit Delete | IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO         | 07/06/2006 | 1,001            |            |                |
|             | 3 Year Period Starts                                                | 10/09/2006 | 1,096            |            |                |
| Edit Delete | Restriction Requirement                                             | 10/20/2006 | 1,107            | (680)      |                |
| Edit Delete | Restriction Requirement Response Received at PTO                    | 11/20/2006 | 1,138            |            |                |
| Edit Delete | Non-Final Office Action                                             | 01/25/2007 | 1,204            |            |                |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO                           | 04/25/2007 | 1,294            |            |                |
| Edit Delete | IDS under 1.704(c)(8) filed at PTO                                  | 07/06/2007 | 1,366            |            | 72             |
| Edit Delete | Final Office Action                                                 | 07/12/2007 | 1,372            |            |                |
|             | Final Office Action + 3 months                                      | 10/12/2007 | 1,464            |            |                |
| Edit Delete | Request For Continued Examination (including amendment)             | 10/31/2007 | 1,483            | (387) 1056 | 19             |
|             | 3 Year Period Stopped                                               | 10/31/2007 | 1,483            |            |                |
| Edit Delete | IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO         | 11/08/2007 | 1,491            |            |                |
| Edit Delete | Non-Final Office Action                                             | 12/13/2007 | 1,526            |            |                |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO                           | 03/13/2008 | 1,617            |            |                |
|             | Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo                    | 07/13/2008 | 1,739            |            |                |
| Edit Delete | Final Office Action                                                 | 07/25/2008 | 1,751            | 12         |                |
| Edit Delete | IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO         | 10/15/2008 | 1,833            |            |                |
|             | Final Office Action + 3 months                                      | 10/25/2008 | 1,843            |            |                |
| Edit Delete | Final Office Action Response Received at PTO                        | 10/27/2008 | 1,845            |            |                |
| Edit Delete | Advisory Action                                                     | 11/12/2008 | 1,861            |            |                |

|             |                                                  |            |         |           |
|-------------|--------------------------------------------------|------------|---------|-----------|
| Edit Delete | Request For Continued Examination (no amendment) | 11/20/2008 | 1,869   | 26        |
| Edit Delete | Non-Final Office Action                          | 02/04/2009 | 1,945   |           |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO        | 03/12/2009 | 1,981   |           |
| Edit Delete | Notice of Allowance                              | 06/11/2009 | 2,072   |           |
| Edit Delete | Issue Fee Paid                                   | 07/07/2009 | 2,098   |           |
| Edit Delete | Patent Grant Date                                | 10/27/2009 | 2,210   |           |
|             |                                                  |            | Totals: | 1,068 117 |
|             |                                                  |            | PTA:    | 951       |

Created and maintained by  
  
FOLEY & LARDNER LLP

Version: 3.02.05

LOGIN: Carolyn Simpson

IP: 10.50.33.60

Foley &amp; Lardner LLP